

REMARKS

Claims 1-7, 9-16, and 18-21 are pending in the present application with claims 1, 9, 11 and 15 being the independent claims. Claims 11-14 are withdrawn from consideration.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Applicants direct the examiner to 35 U.S.C. § 112 ¶ 6 which provides:

An element . . . may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Applicants are permitted by statute to claim elements in the form of a means for performing a function. Accordingly, applicants respectfully request that the examiner withdraw the objection.

Claim 1 was objected to because it recites: *an the submitted*. Applicants have amended the claims to correct the informality.

Claims 15, 16 and 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, the examiner maintains:

Instead of defining the system by identifying the physical structure of the system as set forth in MPEP 2106 (IV)(B)(2)(a), the system as claimed direct to software per se. The rejection of claims 15, 16 and 18-21 under 35 U.S.C. § 101 is sustained.

Applicants respectfully disagree and maintains that there is no legal basis for “a software per se” rejection. Moreover, applicants respectfully direct the examiner to *WMS Gaming Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999). The *WMS Gaming* Court reasoned that “[a] general purpose computer, or microprocessor, programmed to carry out an algorithm creates ‘a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to

instructions from program software.” *Id.* (quoting *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994)).

Applicants respectfully requests that the examiner withdraw the rejection.

Claims 1 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the examiner maintains that the Claimed limitation, “selecting the submitted unmet need for development of a medical product related to the selected unmet need where the submitted unmet need matches a predetermined number of other submissions having the same primary topic,” was not described in the specification.

Applicants respectfully direct the examiner at least to paragraph 34 of the application wherein it states:

Once the submission data is captured, sorted, categorized, and so on, the data may be analyzed either manually, e.g., by a human entering or moving the data to a spreadsheet or a report, or automatically such as by periodically summarizing the data by the number of submissions in a particular category, the number of submission from a particular region, health facility, medical professional etc. FIG. 8 illustrates an example of how the submissions may be analyzed to identify unmet needs of interest. Here, a predetermined level 802 is set. Unmet need is the only unmet need that has exceeded the predetermined level. Of course, it may be that different criteria are employed to identify unmet needs of interest, such as submission from a particular health facility or health professional.

Applicants respectfully requests that the examiner withdraw the rejection.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the examiner maintains that *the submitted unmet need* in claim 1, references to two different unmet needs in the process, e.g., one in the step of accepting and one in categorizing. Applicants have carefully reviewed the claim and submit that the claim is in proper form. The accepting step recites “a submission” while the categorizing step recites “the submission.”

Claims 1-7, 15, 16 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacoby et al. [US 20010034639 A1].

Regarding the rejection of independent claims 1 and 15, the examiner indicated that Jacoby et al. teaches the claimed "accepting on said web site a submission indicative of an unmet need relating to the medical products from a plurality of users." The issue has not changed from the previous action. The applicants submit that the Jacoby et al. does not teach submissions or categorizing unmet needs. Nevertheless, applicants have amended the claim in the interest of expediting prosecution in this matter. The claims were amended to clarify that the submissions are "indicative of a medical need *not addressed by available medical products*." Jacoby by contrast teaches a system for gathering information from various subjects about medical problems and treatments that the subjects have undergone. Unlike the claimed invention, the Jacoby system is a survey system. See Figure 2 A and 2 B of Jacoby.

Applicants request that the examiner enter the amendments to the claims to clarify the issues for appeal.

Claims 4 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacoby et al. [US 20010034639 A1] and drugstore.com [drugstore.com - online pharmacy & drugstore, prescriptions filled]. Applicants respectfully submit that the rejection is incorrect as a matter of law. As the examiner pointed out in the rejection, 102(e) reads as follows:

(e) the invention was described in (1) *an application* for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Emphasis added. Accordingly, an application can be used in a 102(e) rejection and not an application and a publication. For that reason alone, the rejection should be withdrawn.

In the interest of furthering prosecution applicants will consider the rejection under 103(a). Even in such a rejection, applicants submit that the above arguments apply equally and that the rejection is overcome.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over drugstore.com [drugstore.com - online pharmacy & drugstore, prescriptions filled] in view of Applicant Admitted Prior Art [Background of the Invention, pages 1-3].

Regarding the rejection of independent claim 9, the Examiner indicated that drugstore.com teaches the claimed “network accepting an electronic submission indicative of an unmet need for the medical products whereby unmet needs related to the medical products may be determined.” Office action, pp. 9-10. Applicants respectfully disagree and submit that drugstore.com does not teach the claimed “accepting an electronic submission indicative of an unmet need for the medical products whereby unmet needs related to the medical products may be determined” as noted above with respect to claims 1 and 15. The pages of drugstore.com web site relied upon in the Official Action are <http://web.archive.org/web/20000310162140/www.drugstore.com/pharmacy/ayp/ask.asp> (“page 3”) and <http://web.archive.org/web/20000208084226/www.drugstore.com/pharmacy/ayp/default.asp?trx=2113> (“page 4”). Page 3 of the drugstore.com web site allows a user who needs “quick, private information” about the user’s “health or medications” to ask a question by typing the question in the “Your question:” box, providing requested information, and clicking on the “Submit Question” button. Page 4 of the drugstore.com web site has been described previously. However, while drugstore.com teaches accepting submissions of a question related to the user’s health or medications, it is not the same as accepting a submission indicative of an unmet need for the medical products, as claimed by Applicants. Nevertheless, applicants have amended the claim in the interest of expediting prosecution in this matter. The claims were amended to clarify that the submissions are “indicative of a medical need *not addressed by available medical products*.” Applicants submit that the rejection over drugstore.com in view of APA is overcome.

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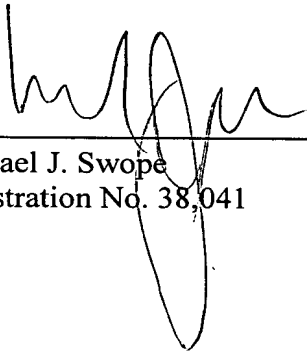
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REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

Applicants submit that the APA does not meet the purported missing teaching of drugstore.com. Therefore, at least for the aforementioned reasons, all of the limitations of claim 9 are not taught or suggested by drugstore.com alone or in combination with APA.

Claim 10 depends from claim 9 and is believed allowable for at least the same reasons as described above with respect to claim 9. Accordingly, reconsideration and withdrawal of the rejection to claims 9-10 is respectfully requested.

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